

**RESPONSE**

**Remarks**

Claims 1-33 are pending in the Application. Claims 1, 14, 19, 25, 30 and 32 are in independent format. Applicant now responds to the Examiner's assertions.

The Applicant traverses all the Examiner's assertions. The Applicant may respond to only certain assertions by the Examiner, but the Applicant intends to traverse all the Examiner's assertions.

**Prosecution Re-Opened After Prior Appeal**

In the Applicant acknowledges that In view of the Appeal Brief filed on 11/8/2007, Reply Brief of 3/31/08 and subsequent interviews with the attorney, prosecution is reopened.

**TELEPHONE INTERVIEW ON June 1, 2009**

The Applicant thanks the Examiner for his courtesy and insight during the telephone interview on June 1, 2009. The Applicant's response is based on the understanding and insights gained from this telephone interview with the Examiner. The Applicant has amended the claims to further distinguish the invention.

### **Section 101 Rejection**

The Examiner asserts "Method claims 1-13, 14-18, and 19-24 are rejected under 35 U.S.C. 101 because in order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter."

### **Section 101 Response**

The Applicant traverses all the Examiner's assertions for the Section 101 Rejection. The Applicant has modified the claims based on the Examiner's suggestions. The Applicant requests the Examiner now withdraw the Section 101 rejections.

### **Claim Objections**

The Examiner asserts "Claims 2, 15, 20 and 26 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The previous claims are method claims, and inclusion an item such as "a computer readable medium" does not further limit does not further limits the scope of "protecting domain name registrations ..." and steps of "accepting information ...", "accepting ..." and "issuing a permanent registration ...". Claims 2, 15, 20 and 26

appear to be independent product claims (computer readable and storage medium) containing instructions for causing a processor to execute the steps similar to claim 1 and should be standing as separate independent claims.”

### **Claim Objections Response**

The Applicant traverses all the Examiner’s assertions for the Claim Objections. The Applicant submits that the claims as originally filed are proper dependent claims.

However, the Applicant has amended the claims and the amended claims. The Applicant requests the claim objections be immediately withdrawn.

### **Section 112, 2<sup>nd</sup> Paragraph Rejection**

The Examiner asserts “Claims 1-13, 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.”

The Examiner objected to the word “perpetually” in Claim 1, 10, 14, 19, 20, 24, 25, 30, 32 as being indefinite.

The Examiner objected to the accepting a one-time permanent registration fee” is vague and indefinite since fee normally refers to the cost of a service or product. From the specification, it appears this phrase appears to mean “accepting a one-time permanent registration fee payment” and therefore, insertion of the term “payment” after “fee” is recommended to improve clarity.

The Examiner objected to Claims 2, 15, 20 and 26 are indefinite because they are hybrid claims, claiming both method comprising a plurality of steps and

an article (product) (computer readable medium) for causing a processor to execute the steps of the method. The claims are vague and indefinite because it did not "apprise a person of ordinary skill in the art of its scope".

### **Section 112, 2<sup>nd</sup> Paragraph Response**

The Applicant traverses all the Examiner's assertions for the Section 112, 2<sup>nd</sup> Paragraph rejections. These rejections are clearly improper.

However, the Applicant has amended the claims as requested by the Examiner. The Applicant requests all the Section 112, 2<sup>nd</sup> Paragraph rejections be immediately withdrawn.

### **First Section 103(a) Rejection**

The Examiner asserts "Claims 30-31 and 32-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN et al in view of Domain Name Registraton.com and further in view of"

### **First Section 103(a) Response**

The Applicant traverses this rejection and all of the Examiner's assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Examiner has left the rejection sentence unfinished. Clarification is requested.

### **Independent Claims 30 and 32:**

The Examiner is reminded that the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S.\_\_\_\_, 82 USPQ2d 1385, 1395-97 (2007) stated rejections on obviousness cannot be sustained by mere conclusory

statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

The Applicant submits the Examiner has not supported a legal conclusion of obviousness under the holding of *KSR International Co.* The Applicant responds as follows.

**1. The Claimed Invention was unpredictable, includes unexpected results and was not obvious to try.**

The claimed invention was unpredictable and includes unexpected results that could not be expected nor predicted from the cited prior art, either alone or in combination.

The cited prior art does not teach, suggest, the claim limitations including creating a permanent registration for an existing domain name previously registered by a public domain name registrar, receiving a one-time permanent registration fee, issuing a permanent registration certificate for the existing domain name, wherein a server uses the permanent registration for the existing domain name registration for automatically determining and verifying all current renewal fee payments due for the existing domain name registration at the public domain name registrar and using a first portion of the one-time permanent registration fee payment to pay all current renewal fee payments and automatically determining and verifying all future renewal fee payments due for the existing domain name registration at the public domain name registrar and using a second portion of the one-time permanent registration fee payment to pay all future renewal fee payments.

None of the cited prior art teaches these features. The results are unexpected because none of the prior art teaches a permanent domain name registration at all

with current renewal fees being paid by a first portion of a one-time a one-time permanent registration fee and future renewal fees being paid by a second portion of a one-time a one-time permanent registration fee.

None of the cited prior art, either alone or in combination, could be used to predict the claimed invention with its unexpected results. The claimed invention was not obvious to try.

**2. Not All Claim Limitations Were Considered by the Examiner**

The claimed invention, includes claim limitations not taught or suggested or even mentioned, by the prior art including, but not limited to, those listed for Number 1.

The Examiner is reminded that to establish a case of *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. The Examiner has not considered all the claim elements. *In re Royka* 400 F.2d 981 (CCPA 1974). Further, the Examiner is reminded that all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The Examiner has not considered all words in the claims drafted by the Applicant. The claim limitation including, but not limited to

The combination of the two prior art references do not teach or suggest all of the claim limitations. Therefore, the combination of the two references is not obvious under the holdings of *In re Royka* and *In re Wilson*.

**3. There is no Suggestion or Motivation to Modify the References**

The Examiner is reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR International Co.* 1396.

The Examiner is also reminded that a statement that modifications of the prior art to meet the claimed invention is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Examiner is also reminded that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. This is a guard against using hindsight in an obviousness analysis. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006).

The Examiner is also reminded if the proposed modification or combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti* 270 F.2d 810 (COPA 1959).

Thus, there is no objective reason to combine the teachings of the cited prior art under the holding of *Ex parte Levengood*.

There is also no teaching, suggestion or motivation to combine the cited references under the holding of *In re Kahn*.

Combining the references would change at least one of the principal operations of Kortizinsky, namely, providing software licenses for software that

has absolutely no association with domain names at all, period. Therefore, the claimed invention is not obvious based on the holding of *In re Ratti*.

Even if these references could be combined technically, the combination of the references still do not teach or suggest all of the claimed limitations of the claimed invention. Therefore, the combination of the cited references still do not render the claimed invention obvious.

**4. There Is No Reasonable Expectation of Success for Combining the References.**

The Examiner is reminded that evidence supporting no reasonable expectation of success of combining two or more references supports a conclusion of nonobviousness; *In re Reinhart*, 531 F.2d 1048 (CCPA 1976).

The cited references have significantly different architectures and data flows and could not be successfully combined technically. Even if these references could be combined technically, the combination of the references still do not teach or suggest all of the claimed limitations of the claimed invention. Therefore, the claimed invention is not obvious based on the holdings of *In re Reinhart*.

Thus, the claimed invention is not predictable and includes unexpected results not expected or predicted from the prior art to satisfy the non-obviousness requirements under the holding of *KSR International Co.*

The other independent claims have claim elements similar to independent claim 1 not taught or suggested by the cited prior art.

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected independent claims to allowance.



## **Dependent Claims**

The arguments for the independent claims discussed above are incorporated by reference. All of the independent claims are non-obvious over the cited prior art. All of the dependent claims add additional features not present in the independent claims. The Examiner is reminded that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected dependent claims to allowance.

### **Second Section 103(a) Rejection**

The Examiner asserts "Claims 1-3, 9, 12-13, 14-18, 19-20, 22-24, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN et al in view of Domain Name Registraton.com and KORITZINSKY et al."

### **Second Section 103(a) Response**

The Applicant traverses this rejection and all of the Examiner's assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant incorporates by reference all arguments for the appeal brief filed on November 7, 2007 by reference. All of the arguments for KORITZINSKY previous argued still apply and are relevant in this response. The Applicant incorporates by references all of the arguments from the First Section 103(a) Response for claims 30-33 by references.

**Independent Claim 1**

The Examiner is reminded that the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S.\_\_\_\_, 82 USPQ2d 1385, 1395-97 (2007) stated rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

The Applicant submits the Examiner has not supported a legal conclusion of obviousness under the holding of *KSR International Co.* The Applicant responds as follows.

**1. The Claimed Invention was unpredictable, includes unexpected results and was not obvious to try.**

The claimed invention was unpredictable and includes unexpected results that could not be expected nor predicted from the cited prior art, either alone or in combination.

The cited prior art does not teach, suggest, the claim limitations including creating a permanent registration for an existing domain name previously registered by a public domain name registrar, receiving a one-time permanent registration fee, issuing a permanent registration certificate for the existing domain name, wherein a server uses the permanent registration for the existing domain name registration for automatically determining and verifying all current renewal fee payments due for the existing domain name registration at the public domain name registrar and using a first portion of the one-time permanent registration fee payment to pay all current renewal fee payments and automatically determining and verifying all future renewal fee payments due for the existing domain name registration at the

public domain name registrar and using a second portion of the one-time permanent registration fee payment to pay all future renewal fee payments.

None of the cited prior art teaches these features. The results are unexpected because none of the prior art teaches a permanent domain name registration at all with current renewal fees being paid by a first portion of a one-time a one-time permanent registration fee and future renewal fees being paid by a second portion of a one-time a one-time permanent registration fee.

None of the cited prior art, either alone or in combination, could be used to predict the claimed invention with its unexpected results. The claimed invention was not obvious to try.

**2. Not All Claim Limitations Were Considered by the Examiner**

The claimed invention, includes claim limitations not taught or suggested or even mentioned, by the prior art including, but not limited to, those listed for Number 1.

The Examiner is reminded that to establish a case of *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. The Examiner has not considered all the claim elements. *In re Royka* 400 F.2d 981 (CCPA 1974). Further, the Examiner is reminded that all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The Examiner has not considered all words in the claims drafted by the Applicant. The claim limitation including, but not limited to

The combination of the two prior art references do not teach or suggest all of the claim limitations. Therefore, the combination of the two references is not obvious under the holdings of *In re Royka* and *In re Wilson*.

### **3. There is no Suggestion or Motivation to Modify the References**

The Examiner is reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR International Co.* 1396.

The Examiner is also reminded that a statement that modifications of the prior art to meet the claimed invention is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Examiner is also reminded that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. This is a guard against using hindsight in an obviousness analysis. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006).

The Examiner is also reminded if the proposed modification or combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti* 270 F.2d 810 (COPA 1959).

Thus, there is no objective reason to combine the teachings of the cited prior art under the holding of *Ex parte Levengood*.

There is also no teaching, suggestion or motivation to combine the cited references under the holding of *In re Kahn*.

Combining the references would change at least one of the principal operations of Kortizinsky, namely, providing software licenses for software that has absolutely no association with domain names at all, period. Therefore, the claimed invention is not obvious based on the holding of *In re Ratti*.

Even if these references could be combined technically, the combination of the references still do not teach or suggest all of the claimed limitations of the claimed invention. Therefore, the combination of the cited references still do not render the claimed invention obvious.

**4. There Is No Reasonable Expectation of Success for Combining the References.**

The Examiner is reminded that evidence supporting no reasonable expectation of success of combining two or more references supports a conclusion of nonobviousness; *In re Reinhart*, 531 F.2d 1048 (CCPA 1976).

The cited references have significantly different architectures and data flows and could not be successfully combined technically. Even if these references could be combined technically, the combination of the references still do not teach or suggest all of the claimed limitations of the claimed invention. Therefore, the claimed invention is not obvious based on the holdings of *In re Reinhart*.

Thus, the claimed invention is not predictable and includes unexpected results not expected or predicted from the prior art to satisfy the non-obviousness requirements under the holding of *KSR International Co.*

The other independent claims have claim elements similar to independent claim 1 not taught or suggested by the cited prior art.

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected independent claims to allowance.

### **Dependent Claims**

The arguments for the independent claims discussed above are incorporated by reference. All of the independent claims are non-obvious over the cited prior art. All of the dependent claims add additional features not present in the independent claims. The Examiner is reminded that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected dependent claims to allowance.

### **Third Section 103(a) Rejection**

The Examiner asserts Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN et al /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13 above, and further in view of CUMMINGS et al.”

### **Third Section 103(a) Response**

The Applicant traverses this rejection and all of the Examiner’s assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant incorporates by reference all arguments from the Second Section 103(a) response above.

The arguments for the independent claims discussed above are incorporated by reference. All of the independent claims are non-obvious over the cited prior art. All of the dependent claims add additional features not present in the independent claims. The Examiner is reminded that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected dependent claims to allowance.

#### **Fourth Section 103(a) Rejection**

The Examiner asserts "Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of MANN et al and CUMMINGS et al."

#### **Fourth Section 103(a) Response**

The Applicant traverses this rejection and all of the Examiner's assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant incorporates by reference all arguments from the Second Section 103(a) response above.

The arguments for the independent claims discussed above are incorporated by reference. All of the independent claims are non-obvious over the cited prior art. All of the dependent claims add additional features not present in the independent claims. The Examiner is reminded that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected dependent claims to allowance.

#### **Fifth Section 103(a) Rejection**

The Examiner asserts "Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of MAPLES ET AL."

#### **Fifth Section 103(a) Response**

The Applicant traverses this rejection and all of the Examiner's assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant incorporates by reference all arguments from the Second Section 103(a) response above.

The arguments for the independent claims discussed above are incorporated by reference. All of the independent claims are non-obvious over the cited prior art. All of the dependent claims add additional features not present in the independent



claims. The Examiner is reminded that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected dependent claims to allowance.

#### **Sixth Section 103(a) Rejection**

The Examiner asserts "Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of ELLIOTT".

#### **Sixth Section 103(a) Response**

The Applicant traverses this rejection and all of the Examiner's assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant incorporates by reference all arguments from the Second Section 103(a) response above.

The arguments for the independent claims discussed above are incorporated by reference. All of the independent claims are non-obvious over the cited prior art. All of the dependent claims add additional features not present in the independent claims. The Examiner is reminded that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected dependent claims to allowance.

**Seventh Section 103(a) Rejection**

The Examiner Asserts "Claims 10-11 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURSTEIN ET AL /Domain Name Registration.com and/or KORITZINSKY et al as applied to claims 1-3, 9, 12-13, and 19-22 above, and further in view of Perpetual Bond Article (Dictionary of Finance and Investment Terms, 1998, "PERPETUAL BOND" definition", page 445)."

**Seventh Section 103(a) Response**

The Applicant traverses this rejection and all of the Examiner's assertions. The Applicant may respond only to specific assertions by the Examiner but intends to traverse all rejections and assertions made by the Examiner.

The Applicant incorporates by reference all arguments from the Second Section 103(a) response above.

The arguments for the independent claims discussed above are incorporated by reference. All of the independent claims are non-obvious over the cited prior art. All of the dependent claims add additional features not present in the independent claims. The Examiner is reminded that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

Therefore the Applicant requests the Examiner withdraw the Section 103 rejection and immediately pass all the rejected dependent claims to allowance.

**PARAGRAPH 20, Page 24 Response**

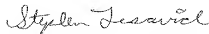
The Applicant traverses this rejection and all of the Examiner's assertions. The Applicant submits that most of the Examiner's assertions are clearly invalid. The assertions the Examiner makes yet again about Kortizinsky are clearly invalid. The Applicant repeats one more time that Koritzinsky does not teach, suggest or even mention domain names or domain name registrations.

**CONCLUSION**

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §103 rejections of all the claims and pass all of the pending claims to allowance.

Respectfully submitted,

**Lesavich High-Tech Law Group, P.C.**



Date: June 2, 2009

By: \_\_\_\_\_

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